UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,750	07/15/2004	Hans-Martin Dietrich	2002P00211WOUS	1048

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Siemens Corporation
Intellectual Property Department
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EXAMINER
LY, NGHI H

ART UNIT	PAPER NUMBER
2617	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on <u>22 November 2006</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>18-32 and 34</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>18-32 and 34</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

1.   The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

DETAILED ACTION

Response to Amendment

2.   Applicant's request for reconsideration of the finality of the rejection of the last

Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

5.   Claims 18-27, 29-32 and 34 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Havinis et al (US 6,311,069) in view of Jokimies (US 6,978,142).

Regarding claims 18 and 34, Havinis teaches a method for requesting the agreement of a user of a mobile terminal of a mobile radio network to the transfer of their position data to a party requesting this position data (see Abstract), the method comprising: defining the privacy data stored in the database server at the central privacy location to assign to the mobile terminal at least one verification rule as to whether an agreement must be obtained on the mobile terminal side to forward the mobile terminal position to the requester (see column 7, lines 60-67), causing, by the switching center of the mobile radio network (Abstract, see "MSC"), in the case of the arrival of a request from a requester for the position of the mobile terminal in the switching center (Abstract, see "MSC" and "positioning request", also see column 2, lines 11-41 and column 3, line 56 to column 4, line 2), the database server at the central privacy location to make a check on the basis of the privacy data stored there (see column 5, lines 41-65), sending the result of the check performed at the central privacy location to the switching center, sending, by the switching center (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC"), if the result at least indicates that an agreement must be obtained (see column 5, lines 41-65), a request for an agreement to the mobile terminal, and transmitting, if the agreement is received by the switching center (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC"), the position of the mobile terminal to the requester (see column 5, lines 41-65 and column 7, lines 10-29).

Havinis does not specifically providing a central privacy location comprising a database server for storing privacy data regarding the mobile terminal, wherein the

central privacy location constitutes <u>a separate location from</u> a Home Location Register
for the mobile terminal.

Jokimies teaches providing a central privacy location comprising a database
server for storing privacy data regarding the mobile terminal (see Abstract, column 7,
lines 5-17 and fig.2, database 37), wherein the central privacy location constitutes <u>a</u>
<u>separate location from</u> a Home Location Register for the mobile terminal (see fig.1, VLR
16 constitutes a separate location from HLR 26, and see [0008], see "*VLR*" and
"*database 16*").

Therefore, it would have been obvious to one of ordinary skill in the art at the
time the invention was made to provide the teaching of Jokimies into the system of
Havinis in order to provide a method and equipment with which the terminals can be
individually controlled to give priority to particular base stations (see Jokimies, column 1,
lines 7-11).

Regarding claim 19, Havinis further teaches the request arrives at a position data
acceptance location of the mobile radio network (see column 6, lines 23-38 and column
7, lines 10-29).

Regarding claim 20, Havinis further teaches the switching center is an MSC
(Mobile Switch Center) or SGSN (Serving GPRS (General Packet Radio Service)
Support Node) (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4,
line 2, see "MSC").

Regarding claim 21, Havinis further teaches requesting, by the switching center,
the position of the mobile terminal from a BSS (Base Station System) or RAN (Reginal

Area Network) (fig.1, see "BSS") of the mobile radio network (see Abstract, column 2,

lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC" and "positioning

requesting").

Regarding claim 22, Havinis further teaches a verification rules specification can

only comprise a prespecified set of different instructions, especially <u>one of</u> the following

instructions: position data transfer without notification, position data transfer with

notification to the mobile terminal, position data transfer only after agreement of the

mobile station or if no response is received from the mobile station, only transfer

position data with the agreement of the mobile station (see column 5, lines 41-65).

Regarding claim 23, Havinis further teaches storing, for a multiplicity of mobile

subscriber identity modules and/or mobile stations, verification rules specifications and

identity specifications for the mobile terminal or for a mobile subscriber identity module

contained in it (see column 6, lines 23-38, column 1, lines 54-64 and column 7, lines 4-

10).

Regarding claim 24, Havinis further teaches regularly receiving, by a switching

center, especially a Visitor Location Register of a switching center from the Home

Location Register of a mobile network the telecommunications address of the database

server or receiving it when a mobile terminal registers at the switching center or its

Visitor Location Register VLR (see column 1, lines 25-43 and column 1, lines 55-64).

Regarding claim 25, Havinis further teaches position data is only transferred to a

requester if this is allowed for the period of the recording of the position according to

stored conditions for the user of the mobile station or its mobile subscriber identity

module through attributes stored in the database (see column 3, lines 8-25 and column 5, lines 41-65).

Regarding claim 26, Havinis further teaches changing the conditions by the user via their mobile terminal or another terminal by mobile radio, WAP (Wireless Application Protocol), Internet, fixed network or in another way (see column 3, lines 8-41 and column 5, lines 41-65).

Regarding claim 27, Havinis further teaches the switching center is the mobile switching center currently being used by the mobile terminal (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC").

Regarding claim 29, Havinis further teaches the database server is a database comprising the verification rules specifications and possibly additional attributes and comprising an additional unit which makes the check (see column 1, lines 55-64).

Regarding claim 30, Havinis further teaches storing the entries in the database server but (see column 1, lines 55-64), to make upwards compatibility with a Home Location Register (also see column 1, lines 55-64), which does not support the improvement of the LCS (Locator Service) Privacy (see column 5, lines 18-65, "LCS") in accordance with the invention, transmitting entries to a mobile network Home Location Register on request or at regular intervals, so that the mobile network Home Location Register can transmit the entries to a switching center (see column 1, lines 55-64).

Regarding claim 30, Havinis further teaches performing a proportion of the checks (see column column 5, lines 45-53, column 6, line 61 to column 7, line 23) in

accordance with a classification in the switching center, and transmitting the result as an

additional input parameter to the database server (see column 55-64).

Regarding claim 30, Havinis further teaches storing the entries in a Home

Location Register (see column 1, lines 55-64, "HLR"), storing only additional attributes

in the database server (see column 1, lines 55-64, "database"), and storing the address

of the database server in the Home Location Register (also see column 1, lines 55-64,

"HLR" and "database").

6.   Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis

et al (US 6,311,069) in view of Jokimies (US 6,978,142) and further in view of Koch (US

6,961,417).

Regarding claim 28, the combination of Havinis and Jokimies teaches a claim 18.

The combination of Havinis and Jokimies does not specifically disclose the database

server is arranged in an SCP (Service Control Point).

Koch teaches the database server is arranged in an SCP (Service Control Point)

(see column 3, line 64 to column 4, line 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide the teaching of Koch into the system of Havinis

and Jokimies in order to provide real-time status, subscriptions, and modifications of

pre-provisioned communication services and parameters (see Koch, column 1, lines 6-

10).

Response to Arguments

7.   Applicant's arguments with respect to claims 18-32 and 34 have been considered

but are moot in view of the new ground(s) of rejection.

Conclusion

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911.

The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly